

amendment to claim 13 is found on page 12, lines 16-20. Entry of the amendments is respectfully requested.

Claims 1-26 stand rejected under 35 U.S.C. § 103 as being obvious over Tipton et al (U. S. Patent 4,594,378). The rejection states that Tipton et al teaches polymeric compositions which have improved shear stability in transmission and hydraulic fluids while maintaining high and low temperature viscosity characteristics. The rejection states that Tipton teaches a mixture of (A) at least one oil-soluble polymer, which can be a homopolymer of C<sub>3-20</sub> olefins, (B-1) nitrogen containing ester of a carboxy-containing interpolymer and/or (B-2) an acrylate polymerization product of an acrylate ester. The rejection states that (A) and (B-2) encompass component (A) of the instant claims. The rejection also states that Tipton et al allows the addition of conventional additives. The rejection states that the conventional additives encompass Applicants' components (C), (D), and (E).

Applicants claims are directed , in one instance (claim 1) to lubricating compositions comprising at least about 30% by weight of at least one mineral oil, having a kinematic viscosity of less than about 8 cSt at 100°C, (A) **from 20% to about 40%** by weight of at least one polymer having a Mw greater than 50,000, and (B) up to about 30% by weight of at least one fluidizing agent, provided that when the fluidizing agent is a poly $\alpha$ -olefin having a kinematic viscosity from about 2 to about 30 cSt at 100°C, then the poly $\alpha$ -olefin is present in an amount up to about 12% by weight, wherein the lubricating composition has a shear loss of less than about 15% in the 20 hour taper bearing shear test.

In another instance (claim 13) to lubricating compositions comprising at least about 30% by weight of at least one mineral oil, having a kinematic viscosity of less than about 8 cSt at 100°C, (A) from 20% to about 40% by weight of at least one polymer having a Mw greater than 50,000, and (B) **from about 10% to about 30%** by weight of at least one fluidizing agent, wherein the lubricating composition has a shear loss of less than about 15% in the 20 hour taper bearing shear test.

The present combination of components provides good low and high temperature properties especially when used in combination with one or more mineral oils. In one aspect, the compositions provide improved oxidation resistance. The taper bearing shear

loss test is a severe shearing test.

As previously pointed out, the present claims are directed to lubricants which have a shear loss of less than 15% in the taper bearing shear test. This test measures permanent shear loss or the reduction of the polymer's ability to thicken the oil. The taper bearing shear test is a severe shear test. Tipton et al is silent as to the type of shear test. Additionally, the lubricants of Tipton are transmission and automatic transmission lubricants. The type of shear seen by these lubricants are lower than the shear generated in the hypoid gears of a gear assembly. Therefore Tipton does not teach or suggest the shear loss limitation of the claims.

Claim 1 has been amended to indicate that the polymer has a Mw less than 50,000 and that the polymer A is present in an amount from 20% to about 40%. Tipton et al teaches that the polymer may be present in an amount from about 0.1% to about 20% with the statement that from about 2% to about 10% was more preferred. In Tipton et al, Examples D-F have polyisobutylene at much lower (4.24, 6.52, and 4.89) level than the required levels of Applicants' claims (i.e. from 20% to about 40% by weight).

Claim 13 has been amended to indicate that the amount of fluidizer is from about 10% to about 30%. Tipton et al teaches that the low temperature viscosity reducing liquid is present in an amount from about 0.1% to about 10%. Tipton et al also teaches that the range of 0.5% to about 5% is more preferred. The Examples of Tipton et al show a use level of 1.05 to 1.61.

Tipton et al does not teach or suggest the levels of the additives required in Applicants' claims. Tipton contains no teachings which would provide guidance to a skilled person to determine the levels of additives needed to provide the claimed lubricants. The Examples of Tipton et al fail to provide any further motivation toward the required levels of polymer (A). The preferred levels taught by Tipton et al lead a skilled person away from the levels required by Applicant's claims.

Since Tipton et al fails to provide guidance to a skilled person which would motivate him to alter the lubricants of Tipton et al to make the lubricating compositions of Applicants' claims, Applicants submit that Tipton et al does not render obvious their claims. Applicants request withdrawal of the rejection and allowance of the claims.

Accordingly, applicants request withdrawal of the rejection and allowance of the claims. In the event any issues remain in the prosecution of this application, Applicants request the Examiner call the undersigned attorney to expedite allowance of the claims. If any fees are required for the filing of these papers, Applicants request the Commissioner to charge those fees to deposit account #12-2275.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, P.L.L.

By William C. Tritt  
William C. Tritt  
Reg. No. 32,510

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113